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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,436	09/18/2003	Daniel R. Armstrong	LTTK.P0103USA	8316

7590 02/21/2006

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EXAMINER

CHEUNG, DAVID

ART UNIT PAPER NUMBER

3713

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/666,436

Applicant(s)

ARMSTRONG ET AL.

Examiner

David Cheung

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**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/18/2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/6/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: On page 5, lines 20 and 26, mobile body 12 is mislabeled as "body 22". On page 6, lines 1 and 3, receiver device 20 is mislabeled as "device 22", transmitter infrared device 22 is mislabeled as "device 20". On page 8, line 10, the sentence for "The rollers 56 and..." is not completed. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9, 10, 11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Choi (US 6,083,104).

For claim 1, Choi discloses a toy convertible between a crawl (cartridge plugged in) mode (Choi, col. 1, line 51-52) and a remote-control (cartridge un-plugged) mode (Choi, col. 1, line 52-53), said toy comprising:

a mobile body (Choi, fig. 1, #20);

an input (Choi, fig. 1, #21) which is attached to the mobile body while the toy is in the crawl mode and which provide a response upon activation while the toy is in the crawl mode (Choi, col. 2, lines 2-5): and

a controller (Choi, fig. 8a, #100) which controls the mobile body from a remote location while the toy is in the remote-control mode.

For claim 2, Choi's toy, wherein the input is provided on the controller, and wherein the controller is attached to the mobile body while the toy is in the crawl mode (Choi, fig. 1).

For claim 3, Choi's toy, wherein the response comprises movement of the mobile body (Choi, col. 1, lines 47-50).

For claim 4, Choi's toy, wherein the response comprises generation of an audible output (Choi, col. 1, lines 60-61).

For claim 5, Choi's toy, wherein the activation comprises manual touching of the input (Choi, col. 1, lines 44-47).

For claim 6, Choi's toy, comprising a plurality of inputs (Choi, fig. 8A, #101-#104, #108-#112).

For claim 7, Choi's toy, wherein at least two of the plurality of inputs provides a different response while the toy is in the remote-control mode (Choi, col. 6, lines 35-39).

For claims 9, Choi's toy, wherein the toy is converted to the crawl mode when the mobile body and the controller are in a certain positional relationship, and wherein the toy is converted to the remote-control mode when the mobile body and the controller are displaced from this positional relationship (Choi, col. 3, lines 56-59).

For claim 10, Choi's toy, wherein the mobile body and the controller include mating members (Choi, col. 6, lines 7-9) which, when mated, placed the toy in the crawl mode and, when un-mated, place the toy in the remote-control mode.

For claim 11, Choi's toy, wherein mating members comprise a recess (Choi, fig. 6, #120) and a tab (Choi, fig. 8A, #121) for receipt into the recess.

For claim 16, Choi discloses a method of playing with the toy, said method comprising the steps of:

placing the toy in the crawl mode, crawling towards the mobile body, and activating the input (Choi, col. 2, lines 2-5); and

placing the toy in the remote-control mode and using the controller to control the mobile body from a remote location (Choi, col. 2, lines 11-16).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi.

For claim 8, Choi discloses a toy wherein each of the plurality of inputs provides a different response while the toy is in the crawl mode or remote-control mode (Choi, col. 6, lines 35-39), but is silent on utilizing them for the same response in the crawl

mode. However, the applicant has not disclosed that utilizing the plurality of inputs for the same response in the crawl mode is for any particular purpose. Moreover, it appears that the plurality of inputs for different responses, or the plurality of inputs for the same response mentioned above, would perform equally well as the input means. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to utilize the plurality of inputs for the same response as the input signal means because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Choi's invention.

For claim 14, Choi discloses a toy wherein the controller comprises a box-shaped member, but is silent on making the controller as a ring-shaped member with a central opening through which the antenna can be inserted. However, the applicant has not disclosed that inserting the antenna through the controller is for any particular purpose. Moreover, it appears that the box-shaped controller, or the ring-shaped controller mentioned above, would perform equally well as the controlling means. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to form the controller into a ring-shape for the antenna to go through as the controlling means because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Choi's invention.

For claim 15, Choi discloses a toy wherein the plurality of buttons are positioned on the top surface of the controller but is silent on positioning the buttons radially on the outer surface of a ring-shaped controller. However, the applicant has not disclosed that by positioning the buttons radially is for any particular purpose. Moreover, it appears

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that by placing the buttons on the top surface of the controller, or radially outer surface of the controller, as mentioned above, would perform equally well as the input means. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to position the plurality of buttons radially onto the controller because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Choi's invention.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi in view of Hoeting (US 6,540,583 B1).

For claim 12, Choi's toy, wherein the mobile body comprises a base (Choi, fig. 2, #20), and movement-providing members attached to the bottom of the base (Choi, col. 1, line 66-col. 2, line 2). Choi discloses infrared as the remote control signal medium and but is silent on the utilization of an antenna. Hoeting discloses a remote controlled toy vehicle with an antenna (Hoeting, fig. 1, #142). It would have been obvious to one skilled in the art at the time of invention to equip Choi's toy with an antenna for better signal reception.

For claim 13, Choi's toy, wherein the movement-providing members comprise rollers rotatably attached to the bottom of the base (Choi, fig. 2, #23 and #25).

Claims 17-19, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi, in view of Hoeting and further in view of Moon (US 6,441,623 B1).

For claim 17, both Choi and Hoeting are silent in disclosing a toy that will provide different outputs in response to different positional relationship of a user. Moon discloses a proximity sensor, for a vehicle, which senses when an object is in the various zones relative to the car, and to provide different outputs in response (Moon, col. 4, lines 5-12). It would have been obvious to one skilled in the art at the time of invention to equip Choi's toy with Moon's proximity sensor for a toy that is more interactive, fascinating, appealing and fun to play with.

For claim 18, the toy of Choi, with the teachings of Hoeting and Moon, wherein the body comprises a base (Choi, fig. 2, #20) and movement-providing members attached to the base (Choi, col. 1, line 66-col. 2, line 2).

For claim 19, the toy of Choi, with the teachings of Hoeting and Moon, wherein the movement-providing members comprise rollers rotatably attached to the bottom of the base (Choi, fig. 2, #23 and #25).

For claim 21, the toy of Choi, with the teachings of Hoeting and Moon, wherein at least one of the response outputs is audio (Choi, col. 1, lines 60-61).

For claim 23, the toy of Choi, with the teachings of Hoeting and Moon, wherein the response outputs are audio, visual, movement, or combinations thereof (Choi, col. 1, lines 47-50 and 60-61).

Claim 20, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi, in view of Hoeting and further in view of Moon.



For claim 20, the toy of Choi, with the teachings of Hoeting and Moon, wherein the body comprises an antenna attached to the top of the base (Hoeting, fig. 1, #142) but has the proximity sensors positioned on the bumper (Moon, col. 1, lines 25-26) instead of within the antenna. However, the applicant has not disclosed that positioning the proximity sensor within the antenna is for any particular purpose. Moreover, it appears that the placement of the sensors in the top front portion of the toy, or within the antenna of the toy, would perform equally well as the proximity sensing means. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to place the proximity sensor within the antenna because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Choi's invention, with the teachings of Hoeting and Moon.

For claim 22, Choi discloses a toy wherein the response outputs are audio, visual, movement, or combination thereof (see rejection for claim 23) but is silent on having both of the response outputs as audio. However, the applicant has not disclosed that utilizing only audio as output is for any particular purpose. Moreover, it appears that the plurality of response outputs, or only audio response output mentioned above, would perform equally well as the output means. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to utilize just audio for the response output because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Choi's invention, with the teachings of Hoeting and Moon.

For claim 24, the toy of Choi, with the teachings of Hoeting and Moon, wherein the first zone Z1 has a range which is greater than 30cm and less than 50cm away from the body and wherein the second zone Z2 is positioned between the body and the first zone Z1 (Moon, col. 4, lines 9-12). Moon does not disclose any other zones lesser than 30cm. Applicant has not disclosed the first zone to be greater than three inches and less than six inches, and the second zone to be between the body and the first zone is for any particular purpose. Moreover, it appears that the farther zones, or the closer zones mentioned above, would perform equally well as the proximity sensing means. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to have the proximity zones closer to the body because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Choi's invention, with the teachings of Hoeting and Moon.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,816,352 – Remote control toy

US 6,491,566 B2 – Sets of toy robots adapted to act in concert


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Cheung whose telephone number is 571-272-2772. The examiner can normally be reached on Monday - Friday, 8am - 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DC



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TC3700